

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on March 8, 2004

Paula F. Durr
Name of Person Mailing
Paula F. Durr
Signature of Person Mailing

AFI 376
#

P&G Case 8819

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of :
Christon : Confirmation No. 6014
Serial No. 10/025,059 : Group Art Unit 3761
Filed December 19, 2001 : Examiner Kidwell
For Absorbent Article

BRIEF ON APPEALS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
MAR 15 2004
TECHNOLOGY CENTER R3700

Dear Sir:

Enclosed, pursuant to 37 C.F.R. 1.192(a), is Appellant's brief on Appeal for the above application. The Brief is being forwarded in triplicate.

The fee for this Brief on Appeal is \$330.00 37 CFR 1.17(c).

The Director is hereby authorized to charge the above fee, or any additional fees that may be required, or credit any overpayment to Deposit Account No. 16-2480 in the name of The Procter & Gamble Company. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

By

Roddy M. Bullock
Roddy M. Bullock
Attorney or Agent for Applicant(s)
Registration No. 37,290
(513) 634-0870

Date: March 8, 2004

Customer No. 27752

(BriefonAppealTrans.doc)
(Last Revised 10/10/2003)



I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on March 8, 2004

Paula F. Durr
Name of Person Mailing
Signature of Person Mailing

P&G Case 8819

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application

Christon et al.

: Confirmation No. 6014

Serial No.: 10/025,059

: Group Art Unit 3761

Filed: December 19, 2001

: Examiner Kidwell

For Absorbent Article

APPELLANTS' BRIEF

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Dear Sir,

RECEIVED
MAR 15 2004
TECHNOLOGY CENTER R3700

This is responsive to the Advisory Action mailed on 2/23/2004 in the above-captioned application, setting a two (2) month period from the date of the Notice of Appeal filed on February 6, 2004, for filing an Appellants' Brief. This Appellant's Brief is being filed in triplicate.

REAL PARTY IN INTEREST

This Application has been assigned to The Procter & Gamble Company of Cincinnati, Ohio. The Inventors, Patricia Lee Christon, Bryan Keith Feller, Ronda Lynn Glassmeyer, and Rosa Alejandra Hernandez, assigned their respective interests to the Procter & Gamble Company in an assignment corresponding to application Serial No. 10/025,059, filed December 19, 2001 (recorded on February 12, 2002, at reel number 012647, and frame number 0335).

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to the Appellants, or known to Appellants' legal representative, that will directly affect the Board's decision in the present appeal.

STATUS OF CLAIMS

The present application was originally filed under 35 USC 111(a) with claims 1-18. Claims 1 and 14 were amended, Claim 18 was cancelled, and Claim 19 was added by an amendment on October 8, 2003. A reply (no claim amendment) was mailed on February 6, 2004

03/12/2004 AWONDAF1 00000029 162480 10025059

01 FC:1402 330.00 DA

has not been entered by the Examiner, for reasons stated in the February 23, 2004 Advisory Action. Claims 1-17 and 19 are pending and are finally rejected.

Appellants appeal the final rejection of Claims 1-17 and 19. The Notice of Appeal for these claims was transmitted by facsimile on February 6, 2004 and received by the Office on February 6, 2004. A complete copy of the appealed claims is set forth in the Appendix.

STATUS OF AMENDMENTS

Appellants' reply mailed on February 6, 2004 contained no amendments to the Claims.

SUMMARY OF INVENTION

The invention provides an absorbent article, such as a sanitary napkin, having an upper surface, a lower surface and a periphery. The article comprises a topsheet having a bottom surface and a viewing surface positioned opposite to the bottom surface. The viewing surface faces upwardly towards the upper surface of the absorbent article. The absorbent article further comprises a backsheet having a garment facing surface and a user facing surface positioned oppositely to the garment facing surface, the backsheet being joined to the topsheet. An absorbent core is positioned between the topsheet and the backsheet, the absorbent core having a top surface and a bottom surface positioned opposite to the top surface. (*See, e.g.*, page 6, lines 13-24).

The absorbent article has a colored portion and a non-colored portion. The colored portion and the non-colored portion are viewable from the viewing surface of the topsheet. The colored portion has at least two shades, a first shade and a second shade. The first shade is positioned substantially within the second shade. The multi-shades operate to create a perception of depth within the absorbent article by a user looking upon the viewing surface of the topsheet. (*See, e.g.*, page 6, line 25 to page 7, line 4).

Other limitations on the relative darkness of the shades, the relative measured value of the shades, the size of the colored portion, the position of the colored portion, and limitations to the absorbent article are claimed in dependent claims 2-17 and 19.

ISSUE

Whether or not US 2003/0114818 issued to Benecke et al. (hereinafter, "Benecke") anticipates the claimed invention under 35 USC 102(e).

GROUPING OF CLAIMS

All the claims stand or fall together.

ARGUMENTS

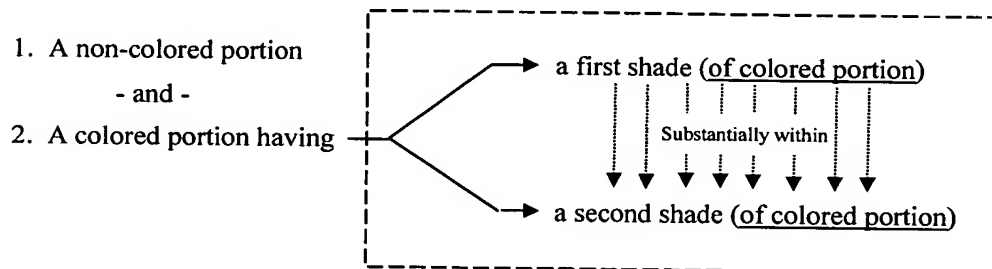
Appellants agree that Benecke teaches a colored portion and a non-colored portion. However, for the reasons set forth below, the Applicant maintains that the invention is patentable over Benecke. Specifically, with respect to Claim 1, Benecke contains no anticipating disclosure for the underlined portions of Claim 1 reproduced below:

...the absorbent article having a colored portion and a non-colored portion, the colored portion and the non-colored portion being viewable from the viewing surface of the topsheet, the colored portion having a first shade and a second shade, the first shade being positioned substantially within the second shade, the second shade being different from the first shade, the shades operating to create a perception of depth within the absorbent article by a user looking upon the viewing surface of the topsheet.

The underlined portion of Claim 1 can be broken down into at least these two claim elements:

- (a) the colored portion having a first shade and a second shade, and
- (b) the first shade being positioned substantially within the second shade.

Simply put, the two elements of Claim 1 above require the sanitary napkin to have the following structural elements, shown diagrammatically:



As set forth below, Benecke does not disclose this structure for Claim 1, and likewise does not disclose further limitations of all the dependent claims.

STANDARD FOR FINDING ANTICIPATION UNDER 35 USC 102

Federal Circuit decisions have repeatedly emphasized that anticipation is established only if (1) all the elements of an invention, as stated in a patent claim,¹ (2) are identically set forth,² (3) in a single prior art reference.³ As shown below, aside from being a single prior art reference, Benecke fails to meet the requirements of this standard.

ARGUMENTS WITH RESPECT TO CLAIM 1

- I. Benecke fails to disclose with sufficient precision an absorbent article having a colored portion and a non-colored portion, wherein the colored portion has a first shade and a second shade such that the subject matter existed in the prior art.**

¹ Verve, LLC v. Crane Cams, Inc., 311 F.3d 1116, 1120, 65 USPQ2d 1051 (Fed. Cir. 2002) ("A single reference must describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. See, e.g., In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) ('the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it').")

² Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) ("Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim."); Glaverbel Societe Anonyme v. Northlake Marketing & Supply, Inc., 45 F.3d 1550, 1554, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995) ("Anticipation requires identity of the claimed process and a process of the prior art; the claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference."; "Anticipation ... requires identity of invention: the claimed invention, as described in appropriately construed claims, must be the same as that of the reference, in order to anticipate."); Tyler Refrigeration v. Kysor Industrial Corp., 777 F.2d 687, 689, 227 USPQ 845, 846-47 (Fed. Cir. 1985) ("identity of invention is a question of fact and the challenger must ordinarily show that each element of the claim in issue is found in a prior patent or publication, either expressly or under principles of inherency").

³ Mehl/Biophile International Corp. v. Milgraum, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1306 (Fed. Cir. 1999) ("To anticipate, a single reference must teach every limitation of the claimed invention."); Oney v. Ratliff, 182 F.3d 893, 51 USPQ2d 1697 (Fed. Cir. 1999); Finnigan Corp. v. U.S. Int'l Trade Comm'n, 180 F.3d 1354, 1367, 51 USPQ2d 1001, 1009 (Fed. Cir. 1999) ("A prior art reference anticipates a patent claim if the reference discloses, either expressly or inherently, all of the limitations of the claim."); General Electric Co. v. Nintendo Co., Ltd., 179 F.3d 1350, 1356, 50 USPQ2d 1910, 1915 (Fed. Cir. 1999) ("A judgment of invalidity for anticipation requires that a single prior art reference disclose every limitation in a patent

With respect to the first requirement the Federal Circuit has stated that the claim elements must be described with sufficient precision and detail to establish that the subject matter existed in the prior art. As shown below, Benecke does not disclose the portion of the claimed invention underlined above with *any* precision, much less “sufficient precision” so as to place the subject matter in the prior art.

Benecke is directed to absorbent articles, such as sanitary napkins, that effectively provide visual masking of absorbed fluids. (See, paragraph [0009]). The color masking device of Benecke is a layer of color masking material. The layer of color masking material is adapted to reduce the visual perception of the red color of menstrual fluid while not interfering with the functionality of the sanitary pad. (See, paragraphs [0034] & [0035]). Benecke provides color masking by providing for variable sized components having different colors and reflectance values. (See, paragraph [0048]).

The “color masking layer” of Benecke is generally disclosed as being achieved by coloring “one or more of the layers of a typical pad’s structure.” (See, paragraph [0059]). FIGS. 2-6 show various embodiments of Benecke’s color masking layer, designated as “14”. The sanitary pad of Benecke can have “one or more” masking layers. (See, paragraph [0066]).

At paragraph [0069] Benecke begins a description of a particular embodiment of a color masking layer comprising “a color masking layer of small, hydrophobic, colored (including white) surfaces on a colored (preferably dark) substrate...” Thus, as Appellants made clear above, Benecke does, indeed, disclose two colors.

The question is, however, does Benecke disclose that one of the two colors has a first shade and a second shade? On page 3 of the Final Office Action the Examiner merely cited parenthetically to paragraph [0073] as disclosing this feature. The Examiner gives no specificity, or reason, for where she finds identically-corresponding disclosure. **To be clear, the Examiner has yet to state with specificity where she finds in Benecke any disclosure of sufficient precision for a colored portion and a non-colored portion, wherein the colored portion has a first shade and a second shade.**

Benecke discloses more details as to the nature of the two colors in paragraphs [0071] – [0075]. The colored hydrophobic surfaces are described, with reference to FIGS. 11a-d and 16, as being colored spots, for example spots “20” in FIG. 16. The hydrophobic surfaces can be any color “within the visible spectrum,” and, can “be more than one color.” (See, paragraph [0075]). In paragraph [0073] it is disclosed that these color surfaces can be enhanced by being backed by a very thin reflective white or metallic layer. Alternatively (and importantly, since this is what the

claim.”); Rockwell International Corp. v. United States, 147 F.3d 1358, 1363, 47

Examiner relied on for anticipation (see, page 3 of Final Office Action)), Benecke discloses an “alternate method to achieve high reflectivity in color surfaces of any color [which] is to use fluorescent pigments or dyes or mix highly reflective materials in the colored surface pigment or dye.”

Therefore, with respect to one of the colored surfaces (i.e., surface “20” in FIGS. 11 and 16), Benecke simply teaches that the reflectivity can be enhanced by mixing fluorescent pigment or dye into the colored surface pigment or dye.

Benecke discloses nothing about two shades within a colored surface, much less anything of the sort with sufficient precision for anticipation.

Benecke teaches nothing about two shades produced from “mixing” a highly reflective material into the colored pigment, much less anything of the sort with sufficient precision for anticipation.

Benecke neither suggests the benefit of, nor the desirability of, two shades within the colored surface, much less anything of the sort with sufficient precision for anticipation.

Accordingly, because Benecke fails to disclose, teach, or even suggest a colored portion having a first shade and a second shade with sufficient precision, as required by CAFC case law, the Appellants submit that Benecke fails to anticipate Claim 1.

II. Benecke fails to disclose with sufficient precision an absorbent article having a colored portion and a non-colored portion, wherein the colored portion has a first shade and a second shade, the first shade being positioned substantially within the second shade such that the subject matter existed in the prior art.

Further with respect to the first requirement of the Federal Circuit’s standard—that the claim elements must be described with sufficient precision and detail to establish that the subject matter existed in the prior art—Benecke also does not disclose the portion of the claimed invention underlined above with *any* precision, much less “sufficient precision” so as to place the subject matter in the prior art.

As noted above (i.e., in the description of Benecke⁴), Benecke fails to disclose, teach, or even suggest two shades in one colored portion. Therefore, by definition, Benecke also fails to disclose one of the shades being positioned substantially within the second shade. That is, because Benecke does not disclose two shades in one of the colored portions, it is simply

USPO2d 1027, 1031 (Fed. Cir. 1998).

⁴ For purposes of conciseness, the characterization of Benecke will not be repeated with each of Appellants’ arguments.

impossible that Benecke can disclose one of the shades being substantially within the second shade with any precision, much less sufficient precision.

However, even if, Benecke was to disclose two shades in one color, there is no disclosure in Benecke to teach or suggest that one of the shades is, or might be, or can be, or should be, positioned substantially within the other shade. Considering hypothetically, for example, that the fluorescent pigment that is mixed into one colored portion (as disclosed in paragraph [0073], discussed above), produces “two shades,” there is no teaching that this mixing could, much less would, produce the supposed two shades wherein one shade is substantially within the second shade. Indeed, it is difficult to even conceptualize how “mixing” a reflective material into a pigment could even produce such a structure. Such lack of any precision on this point is exactly the opposite of what is required for a finding of anticipation.

On page 3 of the Final Office Action the Examiner merely cited parenthetically to paragraph [0073] as disclosing this feature. The Examiner gives no specificity, or reason, for where she finds identically-corresponding disclosure. **To be clear, the Examiner has yet to state with specificity where she finds in Benecke any disclosure with sufficient precision for a colored portion and a non-colored portion, wherein the colored portion has a first shade and a second shade, the first shade being positioned substantially within the second shade.** In fact, no such identically-corresponding element can be identified in paragraph [0073], or anywhere in Benecke for an absorbent article having a colored portion and a non-colored portion, wherein the colored portion has a first shade and a second shade. Not only has no such identical element been identified during prosecution of the present invention, the Appellants have been unable to derive any such identical elements from a close reading of Benecke.

Benecke discloses nothing about one of the shades being positioned substantially within the second shade, much less anything of the sort with sufficient precision for anticipation.

Benecke teaches nothing about one of the shades being positioned substantially within the second shade produced from “mixing” a highly reflective material into the colored pigment, much less anything of the sort with sufficient precision for anticipation.

Benecke neither suggests the benefit of, nor the desirability of, one of the shades being positioned substantially within the second shade, much less anything of the sort with sufficient precision for anticipation.

Accordingly, because Benecke fails to disclose, teach, or even suggest one of the shades being positioned substantially within the second shade at all, much less with sufficient precision, the Appellants submit that Benecke fails to anticipate Claim 1.

III. Benecke fails to *identically set forth* an absorbent article having a colored portion and a non-colored portion, wherein the colored portion has a first shade and a second shade such that the subject matter existed in the prior art.

With respect to the second requirement of the Federal Circuit's standard for finding anticipation (stated above), all the claim elements of the invention must not only be disclosed with sufficient precision in the prior art, but they must be identically set forth.

As noted above (*i.e.*, in the description of Benecke), Benecke fails to disclose, teach, or even suggest a colored portion having a first shade and a second shade. There is no discussion of "shades" of color in one colored portion, and there is no indication that in any discussion of color Benecke intended to have a colored portion having two shades.

Although it is clear that anticipation does not require *ipsissimis verbis* correspondence for each claim term, it is settled law that anticipation requires identity.⁵ Federal Circuit decisions, explicitly or implicitly, reject any standard of "substantial identity."⁶ For each element, the allegedly anticipating reference must have an identically-corresponding element.

On page 3 of the Final Office Action the Examiner merely cited parenthetically to paragraph [0073] as disclosing this feature. The Examiner gives no specificity, or reason, for where she finds identically-corresponding disclosure. **To be clear, the Examiner has yet to state with specificity where she finds in Benecke any disclosure for a colored portion and a non-colored portion, wherein the colored portion has a first shade and a second shade.** In fact, no such identically-corresponding element can be identified in paragraph [0073], or anywhere in Benecke for an absorbent article having a colored portion and a non-colored portion, wherein the colored portion has a first shade and a second shade. Not only has no such identical element been identified during prosecution of the present invention, the Appellants have been unable to derive any such identical elements from a close reading of Benecke.

The requirement for identity means that the identical invention must be shown in as complete detail as is contained in the patent claim.⁷ Notions of concept, essence, or gist are no more useful in the context of Section 102 than elsewhere, because they divert the fact finder's attention from the subject matter of the invention as a whole.⁸ In this case, Benecke does not

⁵ Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1987).

⁶ See Key Pharmaceuticals v. Hercon Laboratories Corp., 161 F.3d 709, 718-19, 48 USPQ2d 1911, 1919 (Fed Cir. 1998).

⁷ Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). The claimed invention, as described in the appropriately construed claims, must be the same as that of the reference, in order to anticipate. Glaverbel S.A. v. Northlake Mkt'g & Supp. Inc., 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995).

⁸ Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 227 USPQ 37 (Fed. Cir. 1985).

show, teach or disclose even the concept or essence of a colored portion having a first and second shade. To consider the notions of Benecke even in their broadest sense, therefore, does not reach identity—that is, Benecke does not show in as complete detail as is contained in the patent claim a colored portion having a first and second shade.

Emphasizing "the rigors of anticipation," the Federal Circuit, in Motorola, Inc. v. Interdigital Technology Corp. (1997)⁹, held that a jury's verdict that one patent claim was anticipated by a prior art reference could not stand because the reference lacked a limitation the claim required. As clearly shown above, Benecke can also not stand as an anticipating reference because it lacks a limitation the claim requires, namely it does not teach "a colored portion having a first shade and a second shade" as required by the claimed invention.

Accordingly, because Benecke fails to disclose identically an absorbent article having a colored portion having a first shade and a second shade, the Appellants submit that Benecke fails to anticipate Claim 1.

IV. Benecke fails to *identically set forth* an absorbent article having a colored portion and a non-colored portion, wherein the colored portion has a first shade and a second shade, the first shade being positioned substantially within the second shade such that the subject matter existed in the prior art.

Further with respect to the second requirement of the Federal Circuit's standard for finding anticipation, all the claim elements must not only be disclosed with sufficient precision, but they must also be identically set forth, including the element that "the first shade being positioned substantially within the second shade..."

As noted above (*i.e.*, in the description of Benecke), Benecke fails to disclose, teach, or even suggest a first shade being positioned substantially within a second shade. There is no discussion of "shades" of color, and there is no indication that in any discussion of color that Benecke intended to have a colored portion having two shades, including a first shade being positioned substantially within the second shade. Because such elements are not even suggested, it is impossible that they could be identically set forth.

Although it is clear that anticipation does not require *ipsissimis verbis* correspondence for each claim term, it is settled law that anticipation requires identity.¹⁰ For each element, the allegedly anticipating reference must have an identically-corresponding element. No such identically-corresponding element has been identified in Benecke for an absorbent article having a

⁹ Motorola, Inc. v. Interdigital Technology Corp., 121 F.3d 1461, 43 USPQ2d 1481 (Fed. Cir. 1997).

colored portion having a first shade and a second shade, first shade being positioned substantially within the second shade. Not only has no such identical element been identified during prosecution of the present invention, the Appellants have been unable to derive any such identical elements from a close reading of Benecke.

On page 3 of the Final Office Action the Examiner merely cited parenthetically to paragraph [0073] as disclosing this feature. The Examiner gives no specificity, or reason, for where she finds identically-corresponding disclosure. **To be clear, the Examiner has yet to state with specificity where she finds in Benecke any disclosure for a colored portion and a non-colored portion, wherein the colored portion has a first shade and a second shade, the first shade being positioned substantially within the second shade.** In fact, no such identically-corresponding element can be identified in paragraph [0073], or anywhere in Benecke for an absorbent article having a colored portion and a non-colored portion, wherein the colored portion has a first shade and a second shade. Not only has no such identical element been identified during prosecution of the present invention, the Appellants have been unable to derive any such identical elements from a close reading of Benecke.

The requirement for identity means that the identical invention must be shown in as complete detail as is contained in the patent claim.¹¹ Notions of concept, essence, or gist are no more useful in the context of Section 102 than elsewhere, because they divert the fact finder's attention from the subject matter of the invention as a whole.¹² In this case, Benecke does not show, teach or disclose even the concept or essence of a color having a first and second shade, the first shade being positioned substantially within the second shade. To consider the notions of Benecke in their broadest sense, therefore, does not reach identity—that is, Benecke does not show in as complete detail as is contained in the patent claim for a color having a first and second shade, the first shade being positioned substantially within the second shade.

Emphasizing "the rigors of anticipation," the Federal Circuit, in Motorola, Inc. v. Interdigital Technology Corp. (1997)¹³, held that a jury's verdict that one patent claim was anticipated by a prior art reference could not stand because the reference lacked a limitation the claim required. As clearly shown above, Benecke can also not stand as an anticipating reference because it does not teach an element, namely "a colored portion having a first shade and a second shade" as required by the claimed invention.

¹⁰ Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1987).

¹¹ Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). The claimed invention, as described in the appropriately construed claims, must be the same as that of the reference, in order to anticipate. Glaverbel S.A. v. Northlake Mkt'g & Supp. Inc., 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995).

¹² Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 227 USPQ 37 (Fed. Cir. 1985).

Accordingly, because Benecke fails to disclose identically an absorbent article having a colored portion having a first shade and a second shade, the first shade being positioned substantially within the second shade, the Appellants submit that Benecke fails to anticipate Claim 1.

V. Benecke fails to enable an absorbent article having a colored portion and a non-colored portion, wherein the colored portion has a first shade and a second shade, and the first shade being positioned substantially within the second shade.

To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.¹⁴ Enablement requires that the prior art teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation.¹⁵

Not only does anticipation require identity of claim elements, which, as shown above, Benecke fails to do, anticipation also requires that the anticipating disclosure enable the claimed invention, thus placing the allegedly disclosed matter in the possession of the public.

Since Benecke does not disclose a colored portion having a first shade and a second shade, the first shade being positioned substantially within the second shade, it obviously cannot enable such a structure. However, even if Benecke was taken as disclosing such a structure, it fails to enable one skilled in the art as to how to make or carry out the structure. Specifically, assuming one were led to try, how would one “mix” a fluorescent pigment with a colored surface pigment in order to produce a color having two shades, one of the shades being substantially within the other? Benecke gives no clue. At best, it is left to the imagination of the skilled person. But, of course, it would not even occur to the skilled person unless he or she had hindsight knowledge of the present invention. Even then, it is difficult to imagine how to carry out such a process to achieve the claimed invention.

Even with the benefit of hindsight analysis of the present invention, to do the mixing operation disclosed by Benecke, it would take undue experimentation to actually make the claimed invention. Benecke gives no direction as to how to make two separate colors, much less shades, from the mixing operation. Benecke’s teaching of how to get higher reflectivity gives no

¹³ Motorola, Inc. v. Interdigital Technology Corp., 121 F.3d 1461, 43 USPQ2d 1481 (Fed. Cir. 1997).

¹⁴ PPG industries, inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996). (emphasis added).

¹⁵ Minnesota Mining and Manufacturing Co. v. Chemque, Inc., 303 F.3d 1924, 1301, 64 USPQ2d 1270, 1278 (Fed. Cir. 2002).

instructions as to how to keep the mixing from being uniform to simply give the intended reflective pigment. In fact, Benecke gives no indication of how to do anything with the colored surface except to change the reflectivity by mixing pigments.

Accordingly, Benecke fails to enable an absorbent article having a colored portion and a non-colored portion, wherein the colored portion has a first shade and a second shade, and the first shade being positioned substantially within the second shade. Therefore, Appellants submit that Benecke fails to anticipate Claim 1.

ARGUMENTS WITH RESPECT TO DEPENDENT CLAIMS 2-17 and 19

VI. In addition to failing to anticipate independent Claim 1, Benecke fails to anticipate each of the dependent claims, as set forth below.

Because Claim 1 is novel, dependent Claims 2-17 and 19 are likewise novel. Nevertheless, for completeness, each dependent claim is considered briefly below.

The arguments made above with respect to Claim 1 are incorporated by reference to the arguments for each claim dependent from claim 1. Therefore, while attempting to avoid repeating the details and analysis presented above with respect to Claim 1, the Appellants show below that Benecke fails to disclose all the elements of the dependent claims with sufficient precision, and fails to set forth each element identically, and fails to enable one skilled in the art to make the claimed subject matter.

Claim 2

With respect to Claim 2, because Benecke fails to disclose two shades within a colored portion, it follows that Benecke also fails to disclose that “the first shade of the color is darker than the second shade of the [same] color.” Even if Benecke were read as disclosing two shades of one color (which it does not suggest, certainly not with sufficient precision to identically achieve the claimed invention), there is no teaching in Benecke of one of the shades of the colored portion being darker than the other. Certainly Benecke does not enable one to get the requisite darker shade.

Even if “mixing” a highly reflective material, as taught by Benecke, were to somehow produce two shades in one color, there is no indication that such a reflective material would produce a lighter shade and a darker shade (in one color). It cannot be said that Benecke identically sets forth a lighter shade and a darker shade (in one color), as required by Claim 2.

On page 3 of the Final Office Action the Examiner relied upon alleged disclosure of a lighter and darker relationship of the two colored materials of Benecke (e.g., material 22 and “ribbons” 20). Of course, this is not relevant to the claimed invention, which requires two shades of one color in addition to a second, non-colored portion.

Accordingly, because Benecke fails to identically disclose, teach, or even suggest, and does not enable, a lighter shade and a darker shade (in one color) at all, much less with sufficient precision to achieve the claimed invention, the Appellants submit that Benecke fails to anticipate Claim 2.

Claim 3

With respect to Claim 3, Benecke is silent as to where the Hunter Reflectance Meter test is performed. The claimed invention specifies “being measured from the viewing surface of the topsheet inboard of the absorbent article’s periphery.” Because Benecke is silent on this claim element, it cannot be said that Benecke identically sets forth such a limitation with any precision, much less sufficient precision.

The Examiner is correct in noting that Benecke discloses use of the same Hunter test system. However, the claim is not directed to a general use of the Hunter test, but to a specific, precise application of the Hunter test. A blanket allegation of “disclosure of LAB system utilizing the Hunter test...” falls far short of a finding of anticipation, i.e., identical, enabled, subject matter of Claim 3. As noted, Benecke does not disclose the testing done in the manner claimed in Claim 3.

Accordingly, because Benecke fails to identically disclose, teach, or even suggest “being measured from the viewing surface of the topsheet inboard of the absorbent article’s periphery” at all, much less with sufficient precision to achieve the claimed invention, the Appellants submit that Benecke fails to anticipate Claim 3.

Claim 4

With respect to Claim 4, Benecke is silent as to where and specifically how the Hunter Reflectance Meter test is performed. The claimed invention specifies “a first point, a second point, and a third point on the viewing surface of the topsheet inboard of the periphery of the absorbent article, the first point being measured within the first shade, the second point being measured within the second shade, and the third point being measured within the non-colored portion of the absorbent article, the color differences being calculated using the L, a, and b values by the formula $\Delta E = [(L^*_x - L^*_y)^2 + (a^*_x - a^*_y)^2 + (b^*_x - b^*_y)^2]^{1/2}$.” Because Benecke is silent

on any disclosure corresponding to this claim element, it cannot be said that Benecke identically sets forth such a limitation with any precision, much less sufficient precision.

The Examiner is correct in noting that Benecke discloses use of the same Hunter test system. However, Claim 4 is not directed to a general use of the Hunter test, but, rather, is precisely claiming a specific application, complete with specific locations for testing. A blanket allegation of “disclosure of LAB system utilizing the Hunter test...” falls far short of a finding of anticipation, i.e., identical, enabled, subject matter of Claim 4. As noted, it is not evident from Benecke that such the subject matter is disclosed, in particular the same formula is used, i.e., identically disclosed, for Claim 4.

Accordingly, because Benecke fails to identically disclose, teach, or even suggest the elements of Claim 4 at all, much less with sufficient precision to achieve the claimed invention, the Appellants submit that Benecke fails to anticipate Claim 4.

Claim 5

As with Claim 1, Claim 5 requires that Benecke disclose a color having a first shade and a second shade. However, Claim 5 also requires that a specified color difference be present with respect to the two shades. Because Benecke does not even disclose two shades of one color, it is impossible that it disclose the elements of Claim 5. Specifically, Benecke is silent as to a color difference between two shades of one color, much less a color difference of at least 3.5, as claimed. Therefore, it cannot be said that Benecke identically sets forth such a limitation with any precision, much less sufficient precision.

The Examiner is correct in noting that Benecke discloses use of the same Hunter test system. However, the Examiner’s statement that Benecke’s disclosure of “every value of color space is disclosed (page 4, paragraph 0054) which would provide the claimed color differences” anticipates Claim 5, is wrong. Benecke, at paragraph [0054] is simply making a statement about color in general—not a statement about any differences in color, or the structure of the disclosed pad. That is, in the quoted language of paragraph [0054], Benecke is simply defining what “color” is, before going further to define color values for “the purposes of this application.”

A rejection relying on a general statement about what “color” is, to find identical, enabled, anticipating disclosure for specific, claimed values of color differences, cannot be reasonably maintained. As noted, there is no disclosure in Benecke for the claimed values of color differences in Claim 5.

Accordingly, because Benecke fails to identically disclose, teach, or even suggest, or enable the elements of Claim 5 at all, much less with sufficient precision to achieve the claimed invention, the Appellants submit that Benecke fails to anticipate Claim 5.

Claims 6 and 7

The same arguments made above for Claim 5 are incorporated by reference here for Claims 6 and 7, it being understood that Claims 6 and 7 are directed to differences in color measurements between the shades and the non-colored portion. Briefly, Benecke simply has no disclosure of such limitations. And the reliance on a general statement defining “color” is misplaced.

Accordingly, because Benecke fails to identically disclose, teach, or even suggest the elements of Claims 6 and 7 at all, much less with sufficient precision to achieve the claimed invention, the Appellants submit that Benecke fails to anticipate Claims 6 and 7.

Claim 8

With respect to Claim 8, the Examiner stated on page 4 of the Final Office Action that “Benecke discloses an absorbent article wherein the size of the colored portion ranges from about 5% to about 98% of the viewing surface of the topsheet as set forth at page 14, paragraph 0106.”

There is no such disclosure in paragraph 0106. Paragraph 0106 discloses “opaque areas” covering “50%” of a masking material. The Examiner contended on page 4 of the Final Office Action that the claimed limitations are inherently met. It is difficult to see how disclosure that does not mention the size of colored portions at all can inherently anticipate specific claimed ranges.

Accordingly, because Benecke fails to identically disclose, teach, or even suggest the elements of Claim 8 at all, much less with sufficient precision to achieve the claimed invention, the Appellants submit that Benecke fails to anticipate Claim 8.

Claim 9

With respect to Claim 9, because Benecke fails to disclose two shades within a colored portion, it follows that Benecke also fails to disclose that “the first shade of the color is positioned substantially centrally in relation to the second shade of the colored portion.”

The Examiner on page 4 of the Final Office Action simply alleged anticipation, “as set forth in FIG. 11B.” FIG. 11B shows no such structure as claimed in Claim 9, i.e., two shades of one color in addition to a second, non-colored portion. Even if Benecke were read as disclosing two shades of one color (which it does not suggest, certainly not with sufficient precision to identically achieve the claimed invention), there is absolutely no teaching in Benecke of one of the shades of the colored portion being positioned substantially centrally in relation to the second

shade of the colored portion. Certainly Benecke does not enable one to get the requisite positioning.

Even if “mixing” a highly reflective material, as taught by Benecke, were to somehow produce two shades, there is absolutely no reason to believe that the mixing would somehow produce two shades, one being positioned substantially centrally in relation to the other. It certainly cannot be said that Benecke identically sets forth such a structure.

Accordingly, because Benecke fails to identically disclose, teach, or even suggest, and does not enable, the first shade of the color is positioned substantially centrally in relation to the second shade of the colored portion at all, much less with sufficient precision to achieve the claimed invention, the Appellants submit that Benecke fails to anticipate Claim 9.

Claim 10

With respect to Claim 10, Benecke fails to disclose a colored portion (having two shades) as “an insert between the topsheet and the absorbent core.” The embodiments of Benecke in which colored portions are mentioned are illustrated in FIGS. 11a-d and 16. As shown, the colored portions (i.e., identified as “20”) are always on “top” of the topsheet. Otherwise, the color masking layer illustrated in FIG. 3, for example (which is disposed between the topsheet and absorbent core), is not disclosed as having multiple colors or a color having multiple shades.

The Examiner on page 4 of the Final Office Action referred to “page 7 in paragraph 0071,” which refers to the above-mentioned FIGS. 11a-d, and paragraph [0036] for disclosure of a “containment layer may be covered by a topsheet.” A careful reading of paragraph [0071] reveals no disclosure of the subject matter of Claim 10. The relevance of a containment layer covered by a topsheet is questioned.

Accordingly, because Benecke fails to identically disclose, teach, or even suggest, and does not enable, an insert between the topsheet and the absorbent core at all, much less with sufficient precision to achieve the claimed invention, the Appellants submit that Benecke fails to anticipate Claim 10.

Claim 11

With respect to Claim 11, Benecke fails to disclose a “colored portion [as claimed in Claim 1] forms a part of the topsheet.”

The Examiner’s rejection on page 4 of the Final Office Action stating that “without the optional topsheet, the colored portion would form a part of the topsheet” is difficult to follow. Presumably, the Examiner’s position is that, because Benecke teaches that the topsheet is optional, the topsheet can be removed from Benecke, and something else *becomes* the topsheet.

Clearly, Benecke fails to identically disclose, teach, or even suggest, and does not enable, a “colored portion [as claimed in Claim 1] forms a part of the topsheet” at all, much less with sufficient precision to achieve the claimed invention. Therefore, the Appellants submit that Benecke fails to anticipate Claim 11.

Claim 12

With respect to Claim 12, Benecke is completely silent about any colored portions in the absorbent core at all, and therefore fails to disclose “the colored portion forms a part of the absorbent core...” As such, Benecke certainly does not teach such an element with sufficient precision to identically achieve the claimed invention. Certainly it cannot be said that Benecke enables one to get have the requisite absorbent core.

The Examiner simply stated on page 4 of the Final Office Action that “the colored layer may be considered a part of the absorbent core...” The Appellants simply rely on the standard of the CAFC quoted above, that requires more than merely “considering” one element to be another. Specifically, the CAFC standard requires identical disclosure, with sufficient precision to show the invention was in the prior art. Clearly, as the Examiner implicitly admits, Benecke falls short of this standard.

Accordingly, because Benecke fails to identically disclose, teach, or even suggest, and does not enable, “the colored portion forms a part of the absorbent core...” at all, much less with sufficient precision to achieve the claimed invention, the Appellants submit that Benecke fails to anticipate Claim 12.

Claim 13

With respect to Claim 13, Benecke is completely silent about any colored portions being “multi-layered inserts” at all, much less “positioned beneath the topsheet,” and, therefore, Benecke fails to disclose “the colored portion forms a part of the absorbent core...” As such, Benecke certainly does not teach such an element with sufficient precision to identically achieve the claimed invention. Certainly it cannot be said that Benecke enables one to get have the requisite absorbent core.

The Examiner simply stated on page 5 of the Final Office Action that “Benecke discloses the colored portion as a multi-layered insert (20, 22) that is positioned beneath the topsheet as set forth on page 2, paragraph 0036 as previously explained in the rejection of claim 10.” However, elements 20 and 22 are not the colored portion of Benecke (at least both elements cannot be construed as “the” colored portion), are not beneath the topsheet, and there is no teaching in paragraph [0036] directed to the colored portion at all, much less multi-layer inserts. The

Appellants again rely on the standard of the CAFC quoted above, which requires more than vague references to paragraph numbers. Specifically, the CAFC standard requires identical disclosure, with sufficient precision to show the invention was in the prior art. Clearly Benecke falls short of this standard.

Accordingly, because Benecke fails to identically disclose, teach, or even suggest, and does not enable, colored portions being “multi-layered inserts” at all, much less “positioned beneath the topsheet,” it is impossible that Benecke could disclose such with sufficient precision to identically achieve the claimed invention. The Appellants submit, therefore, that Benecke fails to anticipate Claim 13.

Claim 14

With respect to Claim 14, Benecke is completely silent about any colored portions being “multi-colored inserts” at all, much less “positioned beneath the topsheet and comprising at least a first layer and a second layer wherein the first layer comprises one shade of the color and wherein the second layer comprises another shade of the color.” Benecke fails to disclose any of the quoted language. As such, Benecke certainly does not teach such elements with sufficient precision to identically achieve the claimed invention. Certainly it cannot be said that Benecke enables one to get have the requisite colored portions.

The Examiner simply stated on page 5 of the Final Office Action that “Benecke discloses a colored portion having a multi-layered insert (see the rejection of claim 1) positioned beneath the topsheet (the optional cover sheet) and comprising at least a first layer (20) and a second layer (22) wherein the first layer comprises one shade of color and wherein the second layer comprises another shade of color as set forth on page 7, in paragraph 0071.”

However, Benecke does not disclose a colored portion that is a multi-layered insert. (Benecke may disclose a multi-layer color masking layer, but that is not what is claimed). Therefore, Benecke does not identically disclose at least that portion of Claim 14. Further, in her rejection, the Examiner mis-characterized the elements “one shade of the color” and “another shade of the color” by leaving out the “the’s” as underlined. This is critical because it is two shades of one colored portion that is claimed. The Appellants again rely on the standard of the CAFC quoted above, that requires more than vague references to paragraph numbers. Specifically, the CAFC standard requires identical disclosure, with sufficient precision to show the invention was in the prior art. Clearly Benecke falls short of this standard.

Accordingly, because Benecke fails to identically disclose, teach, or even suggest, and does not enable, colored portions being “multi-layered inserts” at all, much less “positioned beneath the topsheet,” it is impossible that Benecke could disclose such with sufficient precision

to identically achieve the claimed invention. The Appellants submit, therefore, that Benecke fails to anticipate Claim 14.

Claim 15

With respect to Claim 15, Benecke is completely silent about a topsheet being a formed film. The Examiner's contention on page 5 of the Final Office Action that the containment layer of Benecke is a topsheet is wrong. To contend that because Benecke teaches that a topsheet is optional, and, therefore, the containment layer somehow becomes a topsheet, renders the terms meaningless. Presumably, by this reasoning, if the containment layer were optional the absorbent core would become a topsheet, etc.

Accordingly, because Benecke fails to identically disclose, teach, or even suggest, and does not enable, a topsheet being a formed film, it is impossible that Benecke could disclose such a structure with sufficient precision to identically achieve the claimed invention. The Appellants submit, therefore, that Benecke fails to anticipate Claim 15.

Claim 16

The novelty of Claim 16 rests on the novelty of Claim 1. If Claim 1 is found to lack novelty, then the Appellants agree that Claim 16 lacks novelty.

Claim 17

With respect to Claim 17, Benecke is completely silent about a topsheet comprising both a formed film and a nonwoven. The Examiner's reference on page 5 of the Final Office Action of disclosure at page 3 in paragraph [0043] falls short of finding anticipating disclosure. There is nothing in paragraph [0043] to teach or suggest a topsheet comprising both a formed film and a nonwoven.

Accordingly, because Benecke fails to identically disclose, teach, or even suggest, and does not enable, a topsheet comprising both a formed film and a nonwoven, it is impossible that Benecke could disclose such a structure with sufficient precision to identically achieve the claimed invention. The Appellants submit, therefore, that Benecke fails to anticipate Claim 17.

Claim 19

With respect to Claim 19, Benecke is silent as to the range of coverage of colored portions on the topsheet.

The Examiner on page 5 of the Final Office Action stated that "Benecke discloses a colored portion ranging from about 5% to about 100% of the viewing surface of the topsheet as

set forth at page 7, paragraph 0073.” The Appellants question the accuracy of this statement with respect to the standard for novelty, i.e., identity of claim elements.

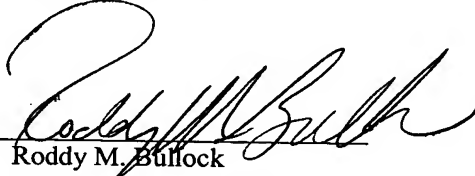
Accordingly, because Benecke fails to identically disclose, teach, or even suggest the elements of Claim 19, the Appellants submit that Benecke fails to anticipate Claim 19.

SUMMARY

In view of all of the above, Appellants respectfully submit that Claim 1 and its dependent Claims 1-17 and 19 are novel. Appellants ask the board to carefully consider the arguments above, and, if the invention is found to be novel, to promptly permit the claims to proceed to allowance.

Respectfully submitted,

By



Roddy M. Bullock
Attorney for Appellants
Registration No. 37,290
Tele. No. (513) 634-0870

Date: *March 8, 2004*

Customer No. 27752

(AppealBrief.doc)
LAST REVISED 10/10/2003

APPENDIX

1. An absorbent article having an upper surface, a lower surface and a periphery, comprising:
 - a topsheet having a bottom surface and a viewing surface positioned opposite to the bottom surface, the viewing surface facing upwardly towards the upper surface of the absorbent article;
 - a backsheet having a garment facing surface and a user facing surface positioned oppositely to the garment facing surface, the backsheet being joined to the topsheet;
 - an absorbent core having a top surface and a bottom surface positioned opposite to the top surface, the absorbent core being positioned between the topsheet and the backsheet; and
 - the absorbent article having a colored portion and a non-colored portion, the colored portion and the non-colored portion being viewable from the viewing surface of the topsheet, the colored portion having a first shade and a second shade, the first shade being positioned substantially within the second shade, the second shade being different from the first shade, the shades operating to create a perception of depth within the absorbent article by a user looking upon the viewing surface of the topsheet.
2. The absorbent article of Claim 1 wherein the first shade of the color is darker than the second shade of the color.
3. The absorbent article of Claim 1 wherein the color of the first shade and the second shade of the colored portion and the non-colored portion are measured by the Hunter Reflectance Meter test according to the colors' L, a, and b values, the L, a, and b values being measured from the viewing surface of the topsheet inboard of the absorbent article's periphery.
4. The absorbent article of Claim 3 wherein the color differences between the colored portion and the non-colored portion are measured at a first point, a second point, and a third point on the viewing surface of the topsheet inboard of the periphery of the absorbent article, the first point being measured within the first shade, the second point being measured within the second shade, and the third point being measured within the non-colored portion of the absorbent article, the color differences being calculated using the L, a, and b values by the formula $\Delta E = [(L^*_X - L^*_Y)^2 + (a^*_X - a^*_Y)^2 + (b^*_X - b^*_Y)^2]^{1/2}$.
5. The absorbent article of Claim 4 wherein the difference in color between the first shade and the second shade is at least 3.5.

6. The absorbent article of Claim 4 wherein the difference in color between the first shade and the non-colored portion is at least 6.
7. The absorbent article of Claim 4 wherein the difference in color between the second shade and the non-colored portion is at least 3.5.
8. The absorbent article of Claim 1 wherein the size of the colored portion ranges from about 5% to about 98% of the viewing surface of the topsheet.
9. The absorbent article of Claim 1 wherein the first shade of the colored portion is positioned substantially centrally in relation to the second shade of the colored portion.
10. The absorbent article of Claim 1 wherein the colored portion is an insert positioned between the topsheet and the absorbent core.
11. The absorbent article of Claim 1 wherein the colored portion forms a part of the topsheet.
12. The absorbent article of Claim 1 wherein the colored portion forms a part of the absorbent core whereby the colored portion is viewable from the viewing surface of the topsheet.
13. The absorbent article of Claim 1 wherein the colored portion is a multi-layered insert positioned beneath the topsheet.
14. The absorbent article of Claim 1 wherein the colored portion comprises a multi-colored insert positioned beneath the topsheet and comprising at least a first layer and a second layer wherein the first layer comprises one shade of the color and wherein the second layer comprises another shade of the color.
15. The absorbent article of Claim 1 wherein the topsheet comprises a formed film topsheet.
16. The absorbent article of Claim 1 wherein the topsheet comprises a nonwoven.
17. The absorbent article of Claim 1 wherein the topsheet comprises a formed film and a nonwoven.
18. (cancelled)
19. The absorbent article of Claim 1 wherein the colored portion ranges from about 5% to about 100% of the viewing surface of the topsheet.